

REMARKS

In this amendment, claim 29 has been amended to recite “provided that said 20-ketosteroid is other than flunisolide.” Support for the amendment can be found throughout the specification, for example, at page 5, lines 24-25 and 29-30, and at page 6, line 5. Thus, the amendment is fully supported by the specification. Claim 37 has been amended to recite that the coating is “fused silica glass.” Support for the amendment can be found in the specification, for example, at page 10, lines 4-12. Claims 1-28 and 38-48 have been previously cancelled. Therefore, claims 29-37 remain pending.

The specification has also been amended to describe Figures 3-5, which were submitted with the originally filed specification. Figures 3-5 were duplicated in the specification at pages 17-19 as Graphs A-C, which have been deleted. Thus, no new matter has been added by these amendments. Furthermore, the specification has been amended to capitalize trademarks found in the specification and therefore, no new matter has been added.

35 U.S.C. § 112, Second Paragraph

The Office noted the use of the trademark “Silcosteel™ process” in the application and requires that it be capitalized wherever it appears and be accompanied by the generic terminology. Applicants have amended the specification to capitalize and note the trademark, and the originally filed specification generically describes the process at page 10, first full paragraph.

The Office also rejected claim 37 as allegedly indefinite for reciting a trademark (the “Silcosteel™ process”). The Office argues that the “process steps and limitations of the said process are not commonly known to all and also it is not permissible to claim a trademark.” Applicants respectfully traverse.

The originally filed specification describes the SILCOSTEEL™ process as a preferred coating process of the invention:

A preferred coating for the metal valve components is a very thin layer of fused silica glass, or other material, deposited by gas vapor deposition . . . The preferred such coating technique is the SILCOSTEEL™ process available from Restek Corporation, Bellefonte, PA. This process deposits a submicron layer of fused silica glass on the metal components and can be used both on the valve components and on the interior of the canister.

See page 10, lines 4-12.

Moreover, the MPEP instructs that the “presence of a trademark or trade name in a claim is not, *per se*, improper under 35 U.S.C. 112, second paragraph” MPEP § 2173.05(u). Nevertheless, in order to expedite prosecution, Applicants have amended claim 37 to delete reference to the trademark and instead to recite that the coating is “fused silica glass,” as the Silcosteel process is defined in the specification.

Accordingly, withdrawal of the rejection is respectfully requested.

35 U.S.C. § 102(e) over Lewis et al (US 2003/0089369)

Claims 29-31 and 34-37 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated over Lewis et al. (U.S. 2003/0089369) (“the Lewis ‘369 publication”). Applicants assert that the Lewis ‘369 publication does not qualify as

102(e) art because the instant application has an earlier filing date than the Lewis '369 publication.

35 U.S.C. § 102(e) states that a person shall be entitled to a patent unless the invention was described in:

- (1) an application for patent, published under section 122(b), ***by another filed in the United States*** before the invention by the applicant for patent or
- (2) a patent granted on ***an application for patent by another filed in the United States*** before the invention by the applicant for patent, ***except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.***

Emphasis added. Thus, the filing date of a foreign priority application is not considered under 35 U.S.C. § 102(e).

According to the face of the publication and on the USPTO's Patent Application Information Retrieval (PAIR) system, the Lewis '369 publication is a continuation of US Application No. 09/831,888, which was filed on July 19, 2001, and which was filed as a national stage application of International Application No. PCT/EP99/09002, which was filed on November 23, 1999. Although Lewis et al. appears to claim priority to two Italian applications, M198A 002559, filed on November 25, 1998, and MI99A 001712, filed on July 30, 1999, the filing dates of these foreign priority documents are not considered under a 102(e) analysis as discussed above. Without acquiescing that Lewis et al. is entitled to its International Application filing date, or any other date, the

earliest possible filing date of the Lewis '369 publication for purposes of the analysis under 35 U.S.C. § 102(e) is November 23, 1999.

In comparison, the instant application, as amended in a Preliminary Amendment dated July 25, 2003, is a continuation of U.S. App. No. 09/970,746, filed October 4, 2001, which is a divisional of U.S. App. No. 09/592,885, filed June 13, 2000 (now U.S. Patent No. 6,315,985), which claims the benefit of U.S. provisional application no. 60/139,961, filed on June 18, 1999. The provisional application contains substantially the same disclosure as the instant application. Therefore, the instant application is entitled to the benefit of the filing date of the provisional application, June 18, 1999, which is before the November 23, 1999, date of the Lewis '369 publication.

Accordingly, the Lewis '369 publication does not qualify as 102(e) art. Withdrawal of the rejection is respectfully requested.

35 U.S.C. § 102(e) over Lewis et al. (US 2003/0066525)

Claims 29-31 and 34-37 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated over Lewis et al. (U.S. 2003/0066525) ("the Lewis '525 publication"). Applicants also assert that the Lewis '525 publication does not qualify as 102(e) art because the instant application has an earlier filing date than the Lewis '525 publication.

The Lewis '525 publication is a divisional application of U.S. App. No. 09/831,888, filed on July 19, 2001, which was filed as a national stage application of International Application No. PCT/EP99/09002, filed on November 23, 1999. The Lewis '525 publication claims priority to the same two Italian priority applications as the Lewis

'369 publication. However, as discussed above, the filing dates of these foreign priority documents are not considered under 35 U.S.C. § 102(e). Therefore, like the Lewis '369 publication, the earliest filing date of the Lewis '525 publication for purposes of 35 U.S.C. § 102(e) is November 23, 1999. Because the instant application is entitled to the filing date of its provisional application, June 18, 1999, the Lewis '525 publication also does not qualify as prior art under 35 U.S.C. § 102(e). Accordingly, Applicants respectfully request withdrawal of the rejection.

35 U.S.C. § 103(a)

Claims 32-33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis et al. (US 2003/0066525) in view of Ercoli et al. (US Patent No. 3,755,302). Applicants respectfully traverse.

As discussed above, the Lewis '525 publication does not qualify as prior art. Therefore, the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn. Applicants respectfully request withdrawal of the rejection.


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this amendment and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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